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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,359	10/27/2003	Chi-Tung Chang	3659-0197PUS1	9437
2292 7590 09/28/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER GODBOLD, DOUGLAS	
			ART UNIT 2626	PAPER NUMBER
			NOTIFICATION DATE 09/28/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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mailroom@bskb.com

<b>Office Action Summary</b>	Application No. 10/696,359	Applicant(s) CHANG ET AL.	
	Examiner Douglas C. Godbold	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 09 August 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office Action is in response to correspondence filed August 9, 2007 with respect to application 10/696,359. Claims 1-12 are pending and have been examined.

#### ***Response to Amendment***

2. The amendments filed August 9, 2007 have been considered and accepted in this application. The Objection to the drawings has been withdrawn. The amendments to claim 1 has also been accepted and considered in this office action.

#### ***Response to Arguments***

3. Applicant's arguments filed August 9, 2007 have been fully considered but they are not persuasive.

In response to applicants argument that Bum does not teach an external memory but instead an internal memory, the examiner respectfully disagrees. The applicant points to the fact that the flash disc 200 of Bum is inserted fully into the housing in figure 2 as evidence flash disc 200 is internal memory. However, this memory is fully removable as shown by figure 2. In fact the description of Figure 2, paragraph 0019 states "FIG. 2 is a perspective view showing the outside construction of an MP3 player that is an embodiment of a host processing device of the present invention and the outside construction of a flash disk that is an embodiment of an **external** storage medium to be combined with the MP3 player." Further the embodiments of Bum

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depicted in figure 7 shows flash drive 710 completely outside housing 750 and connected by a cable 720.

4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the device does not require downloading of sound files via a computer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-12 rejected under 35 U.S.C. 102(e) as being anticipated by Bum (US PgPub 2004/0039575).

7. Consider claim 1, Bum teaches a digital sound file playback reproducer (figures 2-7, comprising:

a housing (figure 3A, housing 100) without an internal memory (the host processing device is not equipped therein with a large capacity non-volatile storage medium for the media files; paragraph 0014. The memory 350 stores an execution program for executing the operations of the MP3 player; paragraph 0037.);

a connection port located at one side of said housing for an external recording medium having sound files stored thereon to connect thereto (figure 2, memory slot 120) ;

a sound source output unit located at one side of said housing, (figure 6, earphone jack 650); and

a processing unit (CPU 340, figure 4) located inside said housing and electrically connected to said connection port (USB Port 320, through interface 330) and said sound source output (through decoder 370 and DAC 380) unit for picking up and processing sound files in said externally connected recording medium, and sending said processed sound files to said sound source output unit (The CPU 340 is connected to the key input unit 310 and the interface unit 330. The CPU 340 integrally controls the respective elements of the system to perform an operation corresponding to a key signal by processing the key signal applied to the key input unit 310, requests and receives MP3 data from the flash disk, and instructs the received MP3 data to be applied to a specific path. Further, the CPU 340 is provided with a USB host function to transmit MP3 data applied to the flash disk to a specific path through the interface unit 330; paragraph 0036) without the use of a memory within the housing (the host processing device is not equipped therein with a large capacity non-volatile storage

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medium for the media files; paragraph 0014. The memory 350 stores an execution program for executing the operations of the MP3 player; paragraph 0037.).

8. Consider claim 2, Bum teaches the digital sound file playback reproducer as claimed in claim 1, wherein said connection port is a USB port (Figure 4, USB port 320).

9. Consider claim 3, Bum teaches the digital sound file playback reproducer as claimed in claim 1, wherein said sound source output unit comprises a headphone jack (figure 6, earphone jack 650).

10. Consider claim 4, Bum teaches the digital sound file playback reproducer as claimed in claim 1, wherein said processing unit includes at least a controller (Figure 4, CPU 340), a decoder (decoder 370), a digital-to-analog converter (DAC 380), and an amplifier (The converted analog data are amplified by an amplification means (for example, power amplifier) and the amplified analog data are output through the speaker to the outside at step S460; paragraph 0044).

11. Consider claim 5, Bum teaches the digital sound file playback reproducer as claimed in claim 1, further comprising an operating unit located at an outer side of said housing and electrically connected to said processing unit for controlling playback of said digital sound files (Figure 4, the key input unit 310 functions to generate a key

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signal to instruct the MP3 player 100 to execute specific operations (for example, reproduction, volume up/down, operation start/end, music selection); paragraph 0035).

12. Consider claim 6, Bum teaches the digital sound file playback reproducer as claimed in claim 5, wherein said operating unit includes a plurality of keys (Figure 4, the key input unit 310 functions to generate a key signal to instruct the MP3 player 100 to execute specific operations (for example, reproduction, volume up/down, operation start/end, music selection); paragraph 0035).

13. Consider claim 7, Bum teaches the digital sound file playback reproducer as claimed in claim 5, wherein said operating unit includes a display panel for displaying operation and/or playback status (figure 4, display 360).

14. Consider claim 8, Bum teaches the digital sound file playback reproducer as claimed in claim 6, wherein said operating unit includes a display panel for displaying operation and/or playback status (figure 4, display 360).

15. Consider claim 9, Bum teaches the digital sound file playback reproducer as claimed in claim 1, further comprising a power supply unit electrically connected to said processing unit for providing working power needed by said digital sound file playback reproducer to work normally (... displays the initial status of the MP3 player 100 for

example, the attachment and detachment of the flash disk, and the remaining power of a battery paragraph 0043).

16. Consider claim 10, Bum teaches the digital sound file playback reproducer as claimed in claim 9, wherein said power supply unit comprises at least one battery (... displays the initial status of the MP3 player 100 for example, the attachment and detachment of the flash disk, and the remaining power of a battery paragraph 0043).

17. Consider claim 11, Bum teaches the digital sound file playback reproducer as claimed in claim 1, wherein said sound files are MP3 (MPEG Audio Layer-3) files (The host processing device 600 of the present invention is connected to the external storage medium 610 through the digital interface 620, reads a media file, such as MP3, WMA, AVI, WMV or MPG file, and processes the media file...; paragraph 0046).

18. Consider claim 12, Bum teaches the digital sound file playback reproducer as claimed in claim 1, wherein said sound files are WMA (Windows Media Audio) files (the host processing device 600 of the present invention is connected to the external storage medium 610 through the digital interface 620, reads a media file, such as MP3, WMA, AVI, WMV or MPG file, and processes the media file... paragraph 0046).



**Conclusion**

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas C. Godbold whose telephone number is (571) 270-1451. The examiner can normally be reached on Monday-Thursday 7:00am-4:30pm Friday 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DCG



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